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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,718	05/16/2001	Carlton Grant Willson	PA27-02V12	2731

7590 12/22/2004

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Legal Department
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EXAMINER

MEEKS, TIMOTHY HOWARD

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,718

Applicant(s)

WILLSON ET AL.

Examiner

Timothy H. Meeks

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~ The MAILING DATE of this communication appears on the cover sheet with the correspondence address ~
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 85-92,94-98,101,103,104 and 107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 85-92,94-98,101,103,104 and 107 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20041018</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/18/04 has been entered.

Specification

The amendments filed 1/16/04 and 7/19/04 are objected to under 35 U.S.C. 132 because they introduce new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The substitute specification filed on 1/16/04 introduces subject matter that the original specification does not reasonably convey that applicants possessed at the time the application was filed. The new subject matter is as follows:

- In paragraph 19 and Figure 1B, a "substance 22" is generically referred to however the original specification only defined this material as a "polymerizable composition".

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- In paragraph 19, support for the sentence "Preferably, substance 22 is.....without requiring high pressures" cannot be found in the original specification.
- In paragraph 20, a "curing agent 24" is generically referred to as being "applied to the template" however, the only "curing agent" described in the original specification as applied in the manner shown in Figure 1C is "activating light" as defined at page 4 of the original specification.
- Almost the entire disclosure at paragraphs 22-24 and Figure 2 lacks a description in the original specification that would reasonably convey that applicants had possession of the subject matter described therein at the time the application was filed. For example, applicants never stated "The resulting structure can be further processed to complete the manufacturing process using well-known techniques" in the original disclosure, nor did they even remotely describe a "course orientation" and "fine orientation" process as is described in the substitute specification. Likewise, the disclosure of an organosilicon solution at paragraph 23 is completely without basis in the original specification. Additionally, a "preliminary etch" and an "oxygen-etching" are not described in the original specification.
- The subject matter added to paragraphs 27 and 33 in the after final amendment filed on 7/19/04 is new subject matter for the reasons more specifically recited in the 112, first paragraph, rejection below.

It is requested that all of the new subject matter be removed from the specification including the drawings.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

Claims 88 and 104 are objected to because of the following informalities: At line 2 of each of these claims, "further includes" should be "further including". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 85-92, 94-98, 101, 103, 104, and 107 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not reasonably convey that applicants had possession of the subject matter added to the claims in the amendment filed on 1/16/04 at the time the application was filed. Applicants' original disclosure only described applying an electric field to a template having a topography as shown in original figure 1. Applicants' explanation of the implied support for these limitations set forth in the after final amendment of 7/19/04 has been fully considered but is not persuasive. Although the now claimed subject matter may describe what occurs when an electric

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field is applied to a template having an uneven topography, the claimed subject matter includes any process for forming adjacent electric fields with different strengths, which includes manners beyond using a template with an uneven topography, which is the only species for which the original specification conveys that applicants possessed at the time the invention was filed. In summary, the original disclosure does not reasonably convey that applicants had possession of all methods for forming the adjacent electric fields with differing strength as is encompassed by the added subject matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 86 and 95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Markush language in these claims is confusing because it is open to species other than those listed. The examiner suggests the following language: "from the group of topologies consisting of...."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 85-92, 94-98, 101, 103, 104, and 107 are rejected under 35

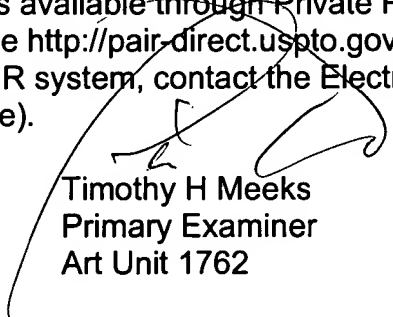
U.S.C. 102(e) as being anticipated by Schaffer et al. (6,391,217).

The process as claimed is explicitly disclosed at Figures 2A-3C, col. 1, lines 43-48, col. 1, line 65 to col. 2, line 5, col. 2, lines 15-20 and 42-55, col. 5, lines 15-20, col. 5, line 60- col. 6, line 10, col. 6, lines 35-40, col. 8, lines 40-55, and examples 2 and 3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy H. Meeks whose telephone number is (571) 272-1423. The examiner can normally be reached on Mon 6-6 and Tues-Thurs 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Timothy H Meeks
Primary Examiner
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